

No. 20662

See Vol. 3376

United States
COURT OF APPEALS
for the Ninth Circuit

ODELOH BROTHERS SWEED MILLS,
INC., et al.,

Appellants,

v.

E MANUFACTURING COMPANY,
a Corporation,

Appellee,

and

E MANUFACTURING COMPANY,
a Corporation,

Appellee and Cross-Appellant,

v.

ODELOH BROTHERS SWEED MILLS,
INC., et al.,

Appellants and Cross-Appellees.

*Appeal from the United States District Court for the
District of Oregon—Civil No. 9702 (Judge Solomon)*

ANSWER TO RESPONSE TO PETITION FOR REHEARING

CKHORN, BLORE, KLARQUIST & SPARKMAN,
NNETH S. KLARQUIST,

703 Board of Trade Building, Portland, Oregon 97204,

AUSE, LINDSAY & NAHSTOLL,

NTH F. KRAUSE,

9th Floor Loyalty Building, Portland, Oregon 97204,

TTS, HOFFMANN, FISHER & HEINKE,

IES T. HOFFMANN,

500 Union Commerce Building, Cleveland, Ohio 44115,

Attorneys for Appellee and Cross Appellant.

STEVENS-NESS LAW PUB. CO., PORTLAND, ORE.

FILED

FEB 15 1967

B201967

WM B LUCK, CLERK

TABLE OF CASES

	Page
Allen v. Standard Crankshaft & Hydraulic Co., 323 F.2d 29 (CA 4, 1963)	4
Bulina et al, Application of, 362 F.2d 555 (CCPA, 1966)	1
Graham v. John Deere Co., 383 U.S. 1	2, 3
Great A. & P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950)	4
Lincoln Eng. Co. v. Stewart-Warner, 1938, 303 U.S. 545	4
Menough, Application of, 323 F.2d 1011 (CCPA, 1963)	5
Petering and Fall, application of, 301 F.2d 676 (CCPA, 1962)	4
Schnitzer v. California Corrugated Culvert, 140 F.2d 275 (CA 9, 1944)	1
U. S. v. Adams, 383 U.S. 39	1

STATUTES

35 U.S.C. 103	1, 4, 5
---------------------	---------

United States
COURT OF APPEALS
for the Ninth Circuit

EDDELOH BROTHERS SWEED MILLS,
INC., et al.,
v.
COE MANUFACTURING COMPANY,
a Corporation,
and
COE MANUFACTURING COMPANY,
a Corporation,
v.
EDDELOH BROTHERS SWEED MILLS,
INC., et al.,

Appellants,
Appellee,
Appellee and Cross-Appellant,
Appellants and Cross-Appellees.

*Appeal from the United States District Court for the
District of Oregon—Civil No. 9702 (Judge Solomon)*

ANSWER TO RESPONSE TO PETITION FOR REHEARING

TO: THE HONORABLE FREDERICK G. HAM-
LEY, M. OLIVER KOELSCH, Circuit Judges,
and JAMES A. WALSH, District Judge:

Petitioner apologizes for the inadvertent errors appearing in the Petition. They do not, of course, in any way affect the contentions advanced.

ERROR IN CONSIDERATION OF PRIOR ART COMPELS RECONSIDERATION OF FINDING OF OBVIOUSNESS

The Petition shows that Streeter does not show means "to accommodate variations in height at the source" (Opinion, p. 10), an assertion not denied in the Response.

The assertion in the Response that Parker's claims do not call for such means ignores the requirement in claims 5, 7 and 17 that the feed end is vertically movable, the only purpose of which movement is to enable accommodation to stack height. See, for example, the stated objects in Parker's specifications, column 1, lines 21-31. Claims are, of course, to be read in connection with the specification. *U. S. v. Adams*, 383 U.S. 39; *Schnitzer v. California Corrugated Culvert*, 140 F.2d 275 (CA 9, 1944).

A finding of obviousness must be supported by a correct understanding of the prior art. See Application of *Bulina et al*, 362 F.2d 555 (CCPA, 1966).

While a correct understanding of the prior art is necessary to a consideration of the contribution of Parker, we do not wish the essential question to be obscured and which is not whether by one way or another Parker's apparatus could be made by fitting together pieces of the prior art, but rather, *was the conception of Parker's combination obvious within the meaning of Sec. 103, and did this Court apply the proper criteria to determine this question?* We submit it did not.

THE COURT ERRED IN DEMANDING TESTS NOT DETERMINATIVE OF OBVIOUSNESS

In *Graham v. John Deere*, 383 U.S. 1, the Supreme Court stated:

“Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevance. See Note, Subtests of ‘Nonobviousness,’ 112 Pa. L. Rev. 1169 (1964).”

The cited article reads in part as follows:

“Courts have difficulty in applying the broad standard of nonobviousness to technical facts. Subtests should be developed . . . based upon non-technical facts.²⁰ Some courts have developed and utilized such subtests, often termed ‘indicia of invention.’²¹” (P. 1172)

“²¹ *Kaakinen vs. Peelers Co.*, 301 F.2d 170, 127-173 (9th Circuit), cert. denied 371 US 83 (1962); . . .”

We have already pointed out the error of this Court in determining the scope and content of the prior art and the differences between Parker and the prior art. Petitioner further submits that the Court also erred in its resolution of the level of ordinary skill in the art of handling veneer, and that

ed in its conclusion of what should be obvious to persons having such skill. The Supreme Court in *Whitcomb* suggests "such secondary considerations as, failure of others, etc. might be utilized" to answer the question. No tests of "different function" or "unusual or surprising" results are suggested. Significantly, the cited article to which the Supreme Court once referred discusses a number of considerations referred to therein as subtests but does not mention "different functions" or "unusual or surprising results." And how better can the level of the skill in the art be evaluated and what was obvious or unobvious to persons having ordinary skill in the art be determined than by such subtests, that is, long felt but unsolved need, failure of others and the opinion of contemporaries working in the art such as the people who refused to even allow the Parker apparatus to be tested in their factories.

The observation of the Fourth Circuit is indeed relevant:

"In approaching the question of obviousness, however, judges should mistrust their subjective notions if there are objective indicia to guide their judgments. Though the answer after the event may appear simple, the Court should not convert its simplicity into obviousness in the face of hard proof of recognized need for the answer, of long, unsuccessful search for the answer by people of skill in the art, of recognition by the industry that the claimed invention was the answer, and of its prompt adoption with attendant commercial success. Even a substantial combination of some of such criteria ought to out-

weigh a judge's subjective convictions that if as skilled as he had really looked for the answer he immediately could have put his finger upon it." *Allen v. Standard Crankshaft & Hydraulic Co.*, 323 F.2d 29 (CA 4, 1963).

Sec. 103 establishes a single standard to be applied to *all* inventions. As observed by the Court of Customs and Patent Appeals in *Application of Petering & Fall*, 301 F.2d 676 (1962):

" . . . Congress did not contemplate various degrees of obviousness in section 103."

This Court indicated in its opinion that, because the patent was one for a combination of mechanical elements, it relied heavily, if not exclusively, on the factors as indicating the obviousness of Parker:

- (1) That none of the *individual* components perform any different function in the combination than they do out of it. (p. 9-10)
- (2) Nothing unusual or surprising was accomplished. (p. 10)

The Court's error resides in its demand that either or both of these tests be met as a *prerequisite* to the finding of unobviousness. No Supreme Court decision, including the *A & P** and the *Lincoln Engineering* decisions, so holds. *Graham*, in fact, rejects such tests.

Whether or not an element performs a new or different function in a combination is not determinative of whether the combining of the elements was obvious. *And whether the combining was obvious is the one and only test required under Sec. 103.*

To impose a requirement that a mechanical element perform some new or different function is

* *A & P v. Supermarket*, 340 U.S. 147.

** *Lincoln Engineering v. Stewart-Warner*, 303 U.S. 4

combination is not in accordance with the patent statutes or the case law of the Supreme Court, would be unconstitutional, and ignores the improbability, even possibility, that mechanical elements can so perform. The Court is respectfully referred to the observation of the Court of Customs and Patent Appeals *Application of Menough*, 323 F.2d 1011 (1963):

“Mechanical *elements* can do no more than contribute to the combination the mechanical functions of which they are inherently capable. The patentability of combinations has always depended on the unobviousness of the combination *per se*.”

The rejection of the “unusual or surprising result” test in *Graham* was discussed in the Petition, page 4. In addition, it should be pointed out the requirement of this test would make only *accidental* invention entitled to a patent. This is contrary to the last proviso of Sec. 103:

“Patentability should not be negated by the manner in which the invention was made.”

CONCLUSION

The Court's holding of the Parker patent invalid based upon principles contrary to the holding of the Supreme Court in *Graham*, contrary to the statute, and unconstitutional. The requested rehearing should be granted because of the far reaching effect of the decision.

Respectfully submitted,

GUNTHER F. KRAUSE,
KENNETH S. KLARQUIST,
JAMES T. HOFFMANN,
Attorneys for Coe Manufacturing Co.

